

REMARKS

Claims 1-28 were examined. The claims have been amended as noted above. Re-examination and reconsideration of the claims, as amended are respectfully requested.

As an initial matter, Applicant wished to disclaim the benefit of prior pending application number 09/466,353. Applicant points out that the sole named inventor on present application was not an inventor in the prior application. Thus, the present application was never entitled to be a continuation-in-part of the prior application.

All claims have been rejected for judicially created double patenting over U.S. Patent Nos. 5,975,893 and 6,217,325, optionally in view of U.S. Patent No. 4,537,689 to Morrow et al. Such rejections are traversed in part and overcome in part.

As an initial matter, Applicants note that independent claims 7 and 14 have been amended to recite that each of the appliances have or are coated with a lubricous composition. Thus, all independent claims of the present application now share this point of novelty over the prior commonly assigned patents. Moreover, for purposes of the following discussion only, Applicant concedes that each and every other element of the present claims are described in the prior commonly assigned patents, except for the coating of the appliances with a lubricous composition.

Before discussing the rejections in detail, Applicant also wishes to point out that the prior commonly assigned patents are available as prior art under both 35 USC §102(e) and possibly §102(a). While Applicant reserves the right to re-file the present application (thus overcoming the §102(e) art availability) and to swear behind the prior patents (thus removing the possible §102(a) art availability), for the present Applicant wishes to argue against the obviousness asserted by the Examiner. In any event, it is noted that the filing of a Terminal Disclaimer would not be sufficient by itself to overcome obviousness rejections stated over these references since they are on their faces available as statutory prior art.

That being said, Applicant believes that the Examiner's reliance on the Morrow '689 patent to teach use of a lubricant with the tooth aligners of the present

application is misplaced. The purpose of an athletic mouth protector, as taught by Morrow '689, and the purpose of a tooth repositioning appliance, as claimed herein, are quite different. The principal purpose of the mouth protector is to reduce the friction and impact on teeth cause by athletic activities. Ideally, the mouth protector would transmit as little force to the teeth as mechanically possible.

In contrast, the tooth positioning appliances of the present invention are intended to transmit repositioning forces to the teeth. The use of a lubricant on such tooth repositioning appliances is counterintuitive. The inventor herein, however, has found that the use of lubricious compositions on such tooth positioning appliances is in fact compatible with their use in applying force to teeth. Such a result was not all predictable prior to the work of the inventor herein.


For these reasons, the claims of the present application, all of which recite the use of a lubricious coating, are distinguishable over the cited art.

In view of the above amendments remarks, Applicants believe that all pending claims are now in condition for allowance and request that the application be passed to issue at an early date.

As a final matter, attached is an Associate Power of Attorney Change of Address. Applicant respectfully requests that the correspondence address be changed as shown.

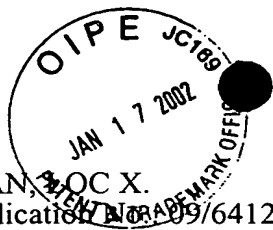
If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400.

Respectfully submitted,


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Enc: *Substitute Power of Attorney
and Change of Address*

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

[The present application is a continuation-in-part of Application No. 09/466,353; filed on December 17, 1999, the full disclosure of which is incorporated herein by reference.]

IN THE CLAIMS:

7. (Amended) A method for repositioning teeth from an initial tooth arrangement to a final tooth arrangement, said method comprising:
- placing a first incremental position adjustment appliance in a patient's mouth, wherein the first appliance has a geometry selected to reposition the teeth from the initial tooth arrangement to a first intermediate arrangement;
 - successively replacing one or more additional appliances, wherein the additional appliances have geometries selected to progressively reposition the teeth from the first intermediate arrangement to successive intermediate arrangements; and
 - placing a final appliance into the patient's mouth, wherein the final appliance has a geometry selected to progressively reposition the teeth from the last intermediate arrangement to the final tooth arrangement, wherein the surface of each appliance has a lubricous composition coupled thereto.
14. (Amended) An improved method for repositioning teeth using appliances comprising polymeric shells having cavities shaped to receive and resiliently reposition teeth to produce a final tooth arrangement, wherein the improvement comprises determining at the outset of treatment geometries for at least three appliances which are to be worn successively by a patient to reposition teeth from an initial tooth arrangement to the final tooth arrangement and coating the interior of each of the polymeric shells with a lubricous composition.